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EXAMINER

MCAVOY, ELLEN M

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 14

Application Number: 09/498,793

Filing Date: February 04, 2000

Appellant(s): BAILLARGEON ET AL.

Malcolm D. Keen  
For Appellant

MAIL EN

DEC 23 2002

**EXAMINER'S ANSWER**

GROUP 1

This is in response to the appeal brief filed 14 October 2002.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellants statement of the status of amendments after final rejection contained in the brief is correct.

No amendment after final has been filed

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellants' statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

Appellant's brief includes a statement that claims 1-4, 6-10 and 14-43 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) *ClaimsAppealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**9) *Prior Art of Record***

6,090,989

TREWELLA et al

7-2000

**(10) *Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-4 and 6-43 stand rejected under 35 U.S.C. 103 over Trewella et al.

Trewella et al [“Trewella”] disclose high performance lubricating oil basestocks which possess unique compositional characteristics and which demonstrate superior low temperature performance properties. The basestocks comprise liquid hydrocarbon compositions containing paraffinic hydrocarbon components in which the extent of branching, as measured by the percentage of methyl hydrogens (BI), and the proximity of branching, as measured by the percentage of recurring methylene carbons which are four or more carbons removed from an end group or branch ( $\text{CH}_2>4$ ) are such that:

- (a)  $\text{BI}-0.5(\text{CH}_2>4)>15$ ; and
- (b)  $\text{BI}+0.85(\text{CH}_2>4)<45$

as measured over said liquid hydrocarbon composition as a whole. See column 3, lines 5-38.

Trewella teaches that the liquid hydrocarbon composition may additionally contain effective amounts of lubricating oil additives such as antioxidants, anti-wear additives, friction modifiers, viscosity index improvers, detergents, etc. See column 3, lines 39-57. The paraffinic hydrocarbon composition of Trewella may be used in combination with other lubricating oil

basestocks such as mineral oils, polyalphaolefins, esters, etc. See column 5, lines 37-42.

Trewella teaches that the liquid hydrocarbon composition is characterized by extremely low pour points of preferably less than or equal to  $-40^{\circ}\text{C}$ , with kinematic viscosities ranging from about 2.0 cSt to greater than about 13 cSt at  $100^{\circ}\text{C}$ , and with high viscosity indices of about 130-165. See column 6, lines 1-15. Thus, the examiner is of the position that the lubricating oil basestocks of Trewella meet the limitations of the liquid lubricant composition of appellants' claims and that a *prima facie* case of obviousness is seen to exist. Although the property of biodegradability is not set forth, the paraffinic basestock of the prior art may be the same as appellants' paraffinic basestock so the degree of biodegradability may also be the same.

#### ***(11) Response to Argument***

In the response filed 17 January 2001, appellants amended independent claim 1, the only independent claim in the application, to recite that the liquid lubricant composition have "a pour point of from about  $-25^{\circ}\text{C}$  to  $-55^{\circ}\text{C}$  and a viscosity index of 130 to 160" and argued that the present claims are directed to lubricant compositions which are formulated using paraffinic basestocks which may be within the scope of the Trewella disclosure but which form a more limited sub-class within the broader class described by Trewella. Appellants argued that the paraffinic wax isomerates used in the presently claimed lubricant compositions are defined in terms which include their viscosity index and their pour point, both of which jointly contribute to the production of finished lubricant compositions which have properties, including

biodegradability, which are not found in nor reasonably could have been predicted from Trewella. This is not deemed to be persuasive of patentability because Trewella actually *prefers* the narrower range of lubricant compositions now claimed by appellants. Trewella teaches that the liquid hydrocarbon composition is characterized by extremely low pour points of less than or equal to  $-18^{\circ}\text{C}$ , preferably less than or equal to  $-30^{\circ}\text{C}$  and more preferably less than or equal to  $-40^{\circ}\text{C}$ , with kinematic viscosities ranging from about 2.0 cSt to greater than about 13 cSt at  $100^{\circ}\text{C}$ , preferably about 4 cSt to about 8 cSt at  $100^{\circ}\text{C}$ , and with high viscosity indices (VI) of about 130-165, preferably from about 140-165 and more preferably from about 150-165. See column 6, lines 1-10. Trewella also discloses the importance of the combination of the properties of pour point and VI. As set forth in column 6, lines 11-15,

"In particular, preferred products of the present invention are lubricant oil basestocks having a combination of VI and pour point from about 130 VI/ $-66^{\circ}\text{C}$  to about 165 VI/ $-27^{\circ}\text{C}$  and more preferably from about 144 VI/ $-40^{\circ}\text{C}$  to about 165 VI/ $-27^{\circ}\text{C}$ ."

In Table 1, column 8, Trewella sets forth properties of basestocks of the invention which meet the new limitations of the claims; example 9 shows a basestock with a kinematic viscosity at  $100^{\circ}\text{C}$  of 5.46 cSt, a VI of 144 and a pour point of  $-40^{\circ}\text{C}$  and example 10 shows a basestock with a kinematic viscosity at  $100^{\circ}\text{C}$  of 7.9 cSt, a VI of 157 and a pour point of  $-42^{\circ}\text{C}$ . These appear to be the closest prior art examples and these examples are clearly within the basestock of some of the claims. It has been well established that unexpected results must be made by comparing the claimed invention against the closest prior art. *In re DeBlauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984); *In re Merchant*, 575 F.2d 865, 869, 197 USPQ 785, 788 (CCPA 1978). The examiner is of the position that the results presented are far too limiting

and are not sufficient to rebut the *prima facie* case of obviousness over the entire claimed range of the paraffinic basestock having a pour point of -25°C to -55°C and a VI of 130-160. It has been well settled that evidence presented to rebut a *prima facie* case of obviousness must be commensurate in scope with the claims to which it pertains and that such evidence which is considerably more narrow in scope than the claimed subject matter is not sufficient to rebut a *prima facie* case of obviousness. *In re Dill*, 604 F.2d 1356, 1361, 202 USPQ 805, 808 (CCPA 1979). Also see *In re Boesch*, 617 F.2d at 276, 205 USPQ 219; *In re Lindner*, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972) and *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). Thus, the examiner maintains the position that Trewella meets the limitations of the liquid lubricant compositions of appellants claims. Although the property of biodegradability is not set forth, the examiner maintains the position that since the paraffinic basestock of the prior art may be the same as appellants' paraffinic basestock, the degree of biodegradability may and most likely is the same. It has been well decided that something which is old does not become patentable upon the discovery of a new property. The claiming of an unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

Appellants grouped the claims into 16 groups which they consider to be separately patentable with respect to one another and presented arguments for each of the groups. Claim group 1 includes claims 1, 2, 6, 7, 9, 10, and 30-36, and appellants argue that the examiner failed to consider the significance of the *selective combination* of the lubricant formulation characteristics set out in these claims and that there is nothing in Trewella which indicates the

possibility of selecting a limited group of branched chain paraffinic hydrocarbons to produce a lubricant composition having a specified combination of low temperature viscometrics and biodegradability. This is not deemed to be persuasive because Trewella does, in fact, teach the combination of certain properties, namely pour point and viscosity index (VI), wherein values of 130 VI/-66°C to about 165 VI/-27°C are taught, to obtain high quality basestocks. These values are within appellants claimed ranges for pour point and viscosity index.

Group 2 includes claims 3, 4, and 8 and appellants argue that the MRV viscosity of the lubricant compositions measured at various low temperatures is no greater than 60,000 cP with a yield stress of not more than about 35 cP and that there is nothing in Trewella which indicates the desirability or the possibility of making finished lubricants with a specified MRV viscosity. The examiner is of the position that since the wax isomerate basestocks of appellants claims may be the same as the basestocks of the prior art, and may be used for the same purpose as automotive engine oils, the wax isomerate basestocks disclosed in Trewella when formulated into lubricating oils by the addition of hydrocarbon fluids and additives may have and most likely will have the same specified values of MRV viscosity.

Group 3 includes claim 10 which specifies a pour point for the basestock of from about -30°C to about -45°C and appellants argue that it is within this range that the optimal lubricant characteristics are achieved. This is not deemed to be persuasive because Trewella discloses pour points preferably less than or equal to -30°C and more preferably less than or equal to -40°C. Appellants argue that Table 1 illustrates the advantage of selection of basestock not by

the lowest achievable pour point but by appropriate and judicious application of other appropriate criteria, including an intermediate pour point as required by the claims in this group. This is not deemed to be persuasive since other factors may have contributed to the improved results obtained in Table 1 such as the selection and amount of the co-base oil added to the formulation and the selection and amount of the additives. The co-base oil is identified as "only"(Ester/Aromatic)". It is not clear if all co-base oils taught in the specification as suitable would have obtained such results.

Group 4 includes claims 14-17 which specify that the lubricant composition have a CCS of not more than 3250 cP at -30°C and an MRV value of not more than 60,000 cP (-40°C) and appellants argue that Trewella does not indicate the possibility that finished lubricants would have or be expected to have this property. This is not deemed to be persuasive since Trewella sets forth in Figure 1 a low temperature viscosity comparison of three oils wherein at -30°C, a CCS viscosity of less than 3250 cP is achieved for the oils. The examiner is of the position that since the wax isomerate basestocks taught by Trewella may be the same as appellants basestocks, the finished lubricant compositions may also be the same, and the CCS and MRV values may be the same or similar.

Group 5 includes claims 18-20 which specify that the finished lubricant composition conforms to the SAE 0W-30 grade and appellants argue that the claims define properties for the finished lubricant which could not have been predicted from Trewella by the skilled person. The examiner is of the position that a skilled person would know how to combine suitable lubricating

oil components with the wax isomerate basestocks set forth in Trewella to yield fully formulated multigrade lubricating oils such as a SAE 0W-30 grade oil.

Groups 6, 7, and 8 include claims 21-26 which specify that the finished lubricant composition conforms to SAE monogrades 5W, 10W and 15W and appellants argue that the monogrades define properties for the finished lubricant which could not have been predicted from Trewella by the skilled person. As previously set forth, the examiner is of the position that a skilled person would know how to combine suitable lubricating oil components with the wax isomerate basestocks of Trewella to make fully formulated lubricating oils having SAE monogrades 5W, 10W and 15W.

Groups 9-16 includes claims 27-29 and 37-43 which specify that the finished lubricant compositions are multigrade lubricants conforming to varoius grades ranging from SAE 0W-20 to 15W-50 and appellants argue that the grades define properties for the finished lubricant which could not have been predicted from Trewella by the skilled person. This is not deemed to be persuasive because the wax isomerate paraffinic hydrocarbon basestock component of appellants claims may be the same as those taught in Trewella and the examiner is of the position that a skilled oil formulator would know how to combine the basestocks with other suitable lubricating oil components to yield fully formulated multigrade lubricating oils. And, although the property of biodegradability is not set forth, the examiner maintains the position that since the paraffinic basestock of the prior art may be the same as appellants' paraffinic basestock, the degree of biodegradability may and most likely is the same. It has been well decided that something which is old does not become patentable upon the discovery of a new property. The claiming of an

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unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

For the above reasons, it is believed that the rejections should be sustained.

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